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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,849	03/21/2001	Yusuke Hayashi	826.1704	1438
21171	7590	06/02/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812,849

Applicant(s)

HAYASHI, YUSUKE

Examiner

Joshua D. Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,8,11,12 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8,11,12,21,23,25,27,29 and 31 is/are rejected.
- 7) ☒ Claim(s) 22,24,26,28,30 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Request for Continued Examination 4/11/2006.
2. Claims 1, 2, 5, 7, 8, 11, 12, and 21-32 are pending in this case. Claims 1, 5, 7, 8, 11, and 12 are independent claims. Claims 1, 2, 5, 7, 8, 11, and 12 have been amended. Claims 3, 4, 6, 9, 10, and 13-20 have been cancelled. Claims 21-32 have been added.

### ***Allowable Subject Matter***

3. Claims 22, 24, 26, 28, 30, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 2, 5, 7, 8, 11, 12, 21, 23, 25, 27, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota (US Patent Number 5,506,902, issued April 9, 1996) in view of Ferguson et al. (hereinafter Ferguson, US Patent Number 5,819,092, issued October 6, 1998).

**Regarding independent claim 1,** Kubota discloses a method, system, computer readable medium, and apparatus for storing a preference corresponding to the user (User ID and subscription settings) in which information is retrieved which indicates a way in which information sets are handled in a source (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). The data obtained is based on the user preferences (subscription terms) (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). The handling information, which indicates how the information sets are handled, is then output to the user terminal (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). At this point the user selects the headline of the article the user wishes to view and that article is then distributed to the terminal and displayed corresponding to the handling information (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). Kubota discloses that the information indicating the way information is handled is based on position in the information source (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). Kubota does not explicitly disclose that a request is received from a user terminal or that a fee is charged to the user specifically for the selected set, rather Kubota discloses that the information request is generated automatically based on the subscription preferences and that the fee is a set subscription fee. However, Ferguson discloses that a user may make specific requests for information rather than the requests be made automatically, and that a user would be charged a fee for accessing specific content at the time it is accessed and that billing information is displayed to the client (Figure 16 and column 31, lines 32-59 of Ferguson). It would have been obvious

to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Kubota with the teachings of Ferguson because it would have provided access to the data at any given time the user wished to view it, unlike a set distribution time, and would have provided the user a way to pay only for the content viewed, unlike a subscription fee.

**Regarding independent claim 2,** Kubota discloses a method, system, computer readable medium, and apparatus for storing a preference corresponding to the user (User ID and subscription settings) in which information is retrieved which indicates a way in which information sets are handled in a source (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). The data obtained is based on the user preferences (subscription terms) (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). The handling information, which indicates how the information sets are handled, is then output to the user terminal (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). At this point the user selects the headline of the article the user wishes to view and that article is then distributed to the terminal and displayed corresponding to the handling information (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). Kubota discloses that the information indicating the way information is handled is based on position in the information source (Figures 12(a) and 12(b) and column 3, lines 33-53 and column 9, lines 1-9). Kubota does not explicitly disclose that a request is received from a user terminal, rather Kubota discloses that the information request is generated automatically based on the subscription preferences. However, Ferguson discloses that a user may

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make specific requests for information rather than the requests be made automatically (Figure 16 and column 31, lines 32-59 of Ferguson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Kubota with the teachings of Ferguson because it would have provided access to the data at any given time the user wished to view it, unlike a set distribution time.

**Regarding independent claims 5, 7, 8, 11, and 12,** the claims incorporate substantially similar subject matter as claim 1. Thus, the claims are rejected along the same rationale as claim 1.

**Regarding dependent claims 21, 23, 25, 27, 29, and 31,** Kubota does not explicitly disclose that a fee is charged to the user specifically based on the importance degree of an article, rather Kubota discloses that the fee is a set subscription fee. However, Ferguson discloses that a user would be charged a fee for accessing specific content based on size the content occupies (Figure 16 and column 31, lines 32-59 of Ferguson), which is one of the defined types of important information clearly laid out in the applicant's specification (page 2, lines 3-11 of applicant's specification). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Kubota with the teachings of Ferguson because it would have provided the user a way to pay only for the content viewed, unlike a subscription fee.

***Response to Arguments***

6. Applicant's arguments filed 4/11/2006 have been fully considered but they are not persuasive.

Regarding arguments on pages 8-10 regarding the limitations based on requesting information and billing the user for information selected for display, the examiner contends that the rejection presented properly teaches all of the necessary claimed limitations and that proper motivation has been presented. Ferguson discloses that a user may make specific requests for information rather than the requests be made automatically, and that a user would be charged a fee for accessing specific content at the time it is accessed and that billing information is displayed to the client (Figure 16 and column 31, lines 32-59 of Ferguson). Ferguson clearly discloses that a user may request information and be billed for the specific information viewed, this in combination with the teachings of Kubota fully discloses the invention as currently claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Kubota with the teachings of Ferguson because it would have provided access to the data at any given time the user wished to view it, unlike a set distribution time, and would have provided the user a way to pay only for the content viewed, unlike a subscription fee.

Regarding arguments on page 10 regarding the idea billing is determined in accordance with the importance degree of an article and that the importance degree is determined based on the display position of the article, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is

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noted that these features upon which applicant relies are not recited in rejected claims 1, 5, 7, 8, 11, and 12. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 22, 24, 26, 28, 30, and 32 deal with how the importance degree is calculated, and the examiner stated that these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 21, 23, 25, 27, 29, and 31 deal with the billing being based on the importance degree, a rejection is provided that properly shows that the billing may be based on size of the article, size being one of the criteria the applicant lists for importance information (page 2, lines 3-11 of applicant's specification). While the examiner understands that claims 22, 24, 26, 28, 30, and 32 provide a more detailed definition of importance degree, claims 21, 23, 25, 27, 29, and 31 are not dependent on these claims and do not incorporate any of those limitations, thus claims 21, 23, 25, 27, 29, and 31 will be interpreted in the broadest possible manner as supported by the specification, which thus requires the rejection as presented to be made.

In response to applicant's argument that Kubota and Ferguson are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.



1992). In this case, Ferguson is pertinent to the problem of providing an electronic newspaper to a client in headline format only, and thus only providing articles which the user selects to read, while Kubota is pertinent to problem of billings users for specific newspaper article content.

### ***Conclusion***

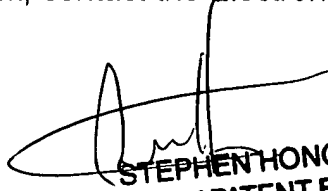
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER

JDC  
May 23, 2006